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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,189	02/15/2002	Akira Tsukihashi	81784.0249	5434

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EXAMINER

AGUSTIN, PETER VINCENT

ART UNIT PAPER NUMBER

2652

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/078,189	TSUKIHASHI, AKIRA	
	<b>Examiner</b>	<b>Art Unit</b>	
	Peter Vincent Agustin	2652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17 is/are rejected.
- 7) ☒ Claim(s) 16 and 18-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. The indicated allowability of claims 15-22 is withdrawn in view of the newly discovered reference(s) to Toyota (US 6,850,473). Rejections based on the newly cited reference(s) follow.

#### *Claim Objections*

2. Claims 1 & 9 are objected to because of the following informalities:

Claim 1, lines 4-5: "the received data" should be --the recovered data--.

Claim 9, lines 4-5: "the received data" should be --the recovered data--.

Claim 9, line 6: "recording address" should be --recording address y--.

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are, e.g., the necessary structural connection between the claimed "encoder" and the other recited elements of the disc recording apparatus of claims 1 & 9.

#### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 9, 15 & 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Toyota (US 6,850,473).

In regard to claim 1, Toyota discloses a disc recording apparatus (Figure 1) for recording data on a disc comprising a disc (8), means (2) for storing data recovered from the disc, an interface (12) for transferring recovered data from the means for storing data and write data to the means for storing data, a CPU (14) for performing confirmation of the received data, and an encoder (4) for generating a recording address for the disc, the disc recording apparatus recording data with a recording address  $y$  calculated from  $y=n(x-m)+m$ , where  $x$  is an absolute time address generated on the basis of a pregroove formed on the disc,  $n$  is a scale factor of recording density, and  $m$  is a recording start address. Note: column 5, line 10 describes "absolute time (absolute address)", which is read to correspond to the claimed recording address  $y$  and the claimed absolute time address  $x$ . In this case, the scale factor  $n$  is equal to 1 since there is no mention of adjusting the start address. Since  $y = x$ , Toyota satisfies the claimed expression  $y=n(x-m)+m$ , where  $n=1$  and  $m$  is any value of the recording start address.

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In regard to claim 9, Toyota discloses a disc recording apparatus (Figure 1) for recording data to a disc comprising a disc (8), means (2) for storing data recovered from the disc, an interface (12) for transferring recovered data from the means for storing data and write data to the means for storing data, a CPU (14) for performing confirmation of the received data, and an encoder (4) for generating a recording address for the disc, the disc recording apparatus recording data with a recording address calculated as  $y=n(x-m)+m$  in the case where an offset address does not exist, where  $x$  is the absolute time address generated on the basis of a pregroove formed on the disc,  $n$  is the scale factor of recording density, and  $m$  is the recording start address (Note: column 5, line 10 describes “absolute time (absolute address)”, which is read to correspond to the claimed recording address  $y$  and the claimed absolute time address  $x$ . In this case, the scale factor  $n$  is equal to 1 since there is no mention of adjusting the start address. Since  $y = x$ , Toyota satisfies the claimed expression  $y=n(x-m)+m$ , where  $n=1$  and  $m$  is any value of the recording start address), and the recording address  $z$  calculated as  $z=y+p$  in the case where recording is performed with the offset address, where  $p$  is the offset address (note “adding an offset value” in column 5, line 11).

Claims 15 & 17 have limitations that are similar to those of claim 1; thus, they are rejected on the same basis.

#### *Allowable Subject Matter*

7. Claims 2-8 & 10-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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8. Claims 16 & 18-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

9. Applicant's arguments, see pages 6-7, filed April 15, 2005, with respect to the rejection(s) of claim(s) 1-14 have been fully considered. The rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Toyota (US 6,850,473).

*Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is 571-272-7567. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on 571-272-7579. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin  
Art Unit 2652

  
BRIAN E. MILLER  
PRIMARY EXAMINER